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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/725,074	12/01/2003	Charles N. Godin	067437-5009-US01	2730
67374 7590 09/01/2009 MORGAN, LEWIS & BOCKIUS, LLP ONE MARKET SPEAR STREET TOWER SAN FRANCISCO, CA 94105				
EXAMINER GORDON, BRIAN R				
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/725,074

Applicant(s)

GODIN ET AL.

Examiner

Brian R. Gordon

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Period for Reply -- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 25 June 2009.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-10, 14-16 and 32-36 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-10, 14-16, 32-36 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SI/08)
- 4) ☐ Interview Summary (PTO-413)
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____
- Paper No(s)/Mail Date _____

DETAILED ACTION

Response to Arguments

1. Applicant's arguments filed June 25, 2009 have been fully considered but they are not persuasive.

In view of applicant's amendment the 102 rejection based upon Bennett et al. (Bennett) is hereby withdrawn

However applicant asserts that Bennett teaches away by disclosing an exemplary heat sealing method. The examiner disagrees. Bennett is not limited only to heat sealing. As previously stated, Bennett states "an elastic membrane 68' could then be secured to the upper surface of the barrel member 52' **by any suitable means** such as heat sealing or a groove and O-ring connection" (column 5, lines 20-23). Heat sealing is disclosed as an exemplary option not a requirement. As specifically disclose any suitable means of sealing may be employed within the device. Therefore the reference does not teach away.

Furthermore applicant has concluded that heat sealing is directed to a permanent seal, but fails to specify where Bennett makes such a statement. The examiner disagrees for any process of sealing that employs eat can be referenced as heat sealing and does not necessarily establish a permanent seal as asserted by applicant. Regardless of such as previously stated, Bennett is not limited to heat sealing.

Furthermore applicant appears to derive at the use of such substances as grease, lubricant or oil, silicon fluid or silicon oil as a sealing agent does not result in a

permanent seal. There is no evidence that such materials cannot be used in the creation of permanent seals or bonds.

Applicant has added new claims 32-36. However applicant has failed to specify where the original specification provides support for the claims. Specifically the examiner fails to locate where support is provided for a removable frame. As such the claims are directed to new matter. Furthermore applicant should take note that Bennett discloses the elastic membrane 68 is attached to a detachable portion of the device (frame).

While applicant has amended claims 3-4, the claims are still not directed to any further structural limitations. A chair is configured to be sat on, but reciting such does not further limit the structure of the chair. One can also choose to sit, kneel, lean, etc. on the chair even though it is configured for sitting. An apparatus is not structurally defined or limited by its intended function.

If view of the above remarks the claims are rejected as given herein below.

Claim Interpretation

2. Claims 3-4 are not further structurally limiting of the claimed system. The "configured to" phrase does not add structure to the device. The claims do not add structure to that of claim 1. The claims are directed to how the device is intended to be used or arranged with respect to the unclaimed fluid receptacles that are not elements of the pipetting system. As to claim 3, is it applicant's intent to further limit the device to include a controller, computer, or other electronic device that allows for automated movement/aligning of the device?

Claim 4 does not add any further structure to that of claim 1. Claim 4 is directed to how one intends for the device to be employed with unclaimed elements (i.e. fluid receptacles and multowell plate).

It should be noted that claim 1 recites one **or** more removable pipette tips. The more pipette tips are optional and not required. As such any dependent claims directed to "the removable pipette tip arrays"; "the pipette tip arrays"; or any other variation thereof are considered limiting only when more than one removable pipette tip is present. The examiner suggests applicant amend the claims to be consistent with the "one or more" language of claim 1.

Claim Objections

3. Claims 3-4 are objected to under 37 CFR 1.75(c), as being of improper dependent form for failing to further limit the subject matter of a previous claim. Applicant is required to cancel the claim(s), or amend the claim(s) to place the claim(s) in proper dependent form.

Specification

4. The lengthy specification has not been checked to the extent necessary to determine the presence of all possible minor errors. Applicant's cooperation is requested in correcting any errors of which applicant may become aware in the specification.

Claim Rejections - 35 USC § 112

5. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact

terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

6. Claims 32-36 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. See Response to Arguments.

7. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

8. Claim 32 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

It is unclear if applicant is attempting to claim a single or plurality of open regions.

The term "an" is singular and the term "regions" is plural.

Claim Rejections - 35 USC § 102

9. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

10. Claims 32-36 are rejected under 35 U.S.C. 102(b) as being anticipated by Bennett et al. US 4, 444,062.

Bennett et al. discloses liquid transfer device having a plunger mounted for sliding movement within a hand-held housing, a plurality of rods projecting from said plunger, a barrel section having a plurality of through-passages formed therein equal in

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number to the number of said rods, means for detachably connecting said barrel means to said housing and elastic diaphragm means adapted to be secured intermediate said housing and barrel means whereby said rods will press said diaphragm into said passages when said barrel means is connected to said housing. The diaphragm can be connected either to the housing over the ends of said rods or may be connected to the barrel means over the passages and the entire barrel means may be formed of plastic material for disposal after a single use. In the disposable form the diaphragm may be of relatively thin material since it does not have to be heavy enough to withstand repeated uses (column 2, line 34).

An elastic rubber membrane 24 of latex completely overlies the recess 16 and the ends of the rods protruding therefrom and the periphery of the membrane is secured in the groove 22 by means of an endless O-ring 26 having dimensions suitable for press fitting the O-ring into the groove 22.

As seen in Figure 1 the membrane is secured to the upper frame and sandwiched between the two respective sections of the frame.

A shallow groove is formed in the upper surface of the barrel member 52 (frame) which completely surrounds the row of wells 60 (open central regions). A thin plastic diaphragm 68 (membrane) of any suitable plastic material having a limited degree of elasticity is stretched over the top of the wells 60 and secured in the groove 67 by means of an elastic O-ring 69 pressed into the groove 67 (clamping assembly). The groove 67 is in alignment with the grooves 22 in the housing 12 when the barrel member 52 is secured to the housing 12.

An elastic membrane 68' could be secured to the upper surface of the barrel member 52' by any suitable means such as heat sealing (sealing agent) (column 5, lines 21-22).

Threaded apertures 56 and screws 54 help align and claim the portions of the frame together.

The device is rectangular in shape as seen in the figures (2-3). The device is further manufactured from plastic (column 2, line 46) and metal (column 3, lines 14-17).

Claim Rejections - 35 USC § 103

11. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

12. In the alternative, claims 1, 3-10 and 14-16 are rejected under 35 U.S.C. 103(a) as being unpatentable over Bennett et al. in view of Yiu et al. 6,258,324.

Bennett does not specify the used of grease, lubricant, oil, silicon fluid, or silicon oil as a sealing agent.

However, Bennett discloses any suitable securing/sealing means may be employed. Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to employ a conventionally known sealing agent such as glue or any other bonding agent within the device of Bennett.

Yiu discloses a pipette device in which silicone oil or grease is employed as a sealing agent. (Abstract).

It would have been obvious to one of ordinary skill in the art at the time of the invention to employ the use of silicon oil or grease as taught by Yiu within the device of Bennett to enhance and preserve the seal.

13. Claim 2 is rejected under 35 U.S.C. 103(a) as being unpatentable over Bennett et al. In view of Yiu as applied to claims 1, 3-10 and 14-16 above, and further in view of Powers, Ingenhoven et al., or Shumate et al.

Bennett et al. in view of Yiu does not disclose the device as being automated.

While a mechanical or automatic means to replace manual activity which has accomplished the same result involves only routine skill in the art, Powers, Ingenhoven et al., or Shumate et al. disclose automated pipette devices.

It would have been obvious to one of ordinary skill in the art at the time of the invention to automate the operation the device of Bennett et al. for automated pipettes are conventionally known in the art to ensure accurate handling of liquid and streamlining various methods as well.

Conclusion

14. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not

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mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Brian R. Gordon whose telephone number is 571-272-1258. The examiner can normally be reached on M-F, 1st Fri. Off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jill Warden can be reached on 571-272-1267. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Brian R Gordon/
Primary Examiner
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